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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,145	12/29/2000	Klim King	CPI-013CNDV4	8048

959            7590            05/22/2003

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[REDACTED] EXAMINER

ULM, JOHN D

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/752,145</b>	Applicant(s)	
	King et al.	
Examiner John Ulm	Art Unit <b>1646</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Mar 10, 2003
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-9, 29, and 30 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-9, 29, and 30 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

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1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 March of 2003 has been entered.

2) Claims 1 to 9, 29 and 30 are pending in the instant application. Claims 29 and 30 have been added as requested by Applicant in Paper Number 11, filed 10 March of 2003.

3) The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 10 and 11, as submitted in Paper Number 11, have been renumbered 29 and 30, respectively.

4) Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

5) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6) Claims 1 to 9, 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling essentially for those reasons of record as applied to

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claims 1 to 9 in section 2 of Paper Number 6. As stated therein, relationship which is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The vast majority of G protein-coupled receptors do not interact with the vast majority of G $\alpha$  subunits. The particular class of G $\alpha$  subunit to which a specific receptor couples determines the type of physiological response produced by that receptor. A critical relationship of the claimed invention is that the mammalian G protein-coupled receptor employed in the claimed cell must be capable of coupling to (compatible with) the mammalian G $\alpha$  subunit employed therein. If one simply chooses a mammalian G protein-coupled receptor and a mammalian G $\alpha$  subunit at random, the claimed yeast cell will most likely not function as disclosed. Claim 1 requires first and second heterologous DNA sequences to "operatively associate". A critical relationship of the instant invention is that the "heterologous G protein coupled receptor" and the "heterologous G protein  $\alpha$  subunit" "operatively associate", and this relationship is not recited in the instant claims, contrary to Applicant's assertion in Paper Number 8, filed 17 June of 2002.

7) The rejections of claims 1 to 7 under 35 U.S.C. § 103 as being unpatentable over the Marullo et al. patent (5,242,822) in view of the Dietzel et al. (Cell 50:1001-1010, 25 Sep. 1987), Herskowitz et al. (Cell 50:995-996, 25 Sept. 1987) and Whiteway et al. (Cell 56:467-477, 10 Feb. 1989) publications for those reasons of record in section 3 of Paper Number 6, and claims 8 and 9 in further view of the Nomoto et al. publication (EMBO J. 9(3):691-696, March

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1990) for those reasons of record on page 7 of Paper Number 6 have been reconsidered in light of Applicant's arguments filed 10 March of 2003 and **withdrawn**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (703) 308-4008. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers filed by fax should be directed to (703) 308-4242 or (703) 872-9306. Official responses under 37 C.F.R. § 1.116 should be directed to (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



JOHN ULM  
PRIMARY EXAMINER  
GROUP 1800